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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/647,517	01/16/2004	Mylavarapu Venkatramesh	16518.132	5271

28381 7590 03/14/2008

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EXAMINER	
CARR, DEBORAH D	
ART UNIT	PAPER NUMBER
1621	

MAIL DATE	DELIVERY MODE
03/14/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/647,517	VENKATRAMESH ET AL.	
	Examiner	Art Unit	
	Deborah D. Carr	1621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 September 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *86,89-94 and 97-110* is/are pending in the application.

4a) Of the above claim(s) *89, 91-92 99-110* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *86,90,93,94,97 and 98* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments, see pages 7-15, filed 14 September 2007, with respect to the rejections under 35 USC§112, 1st paragraph have been fully considered and are persuasive. The rejections of claims 86, 89-94, and 97 have been withdrawn.

2. Applicant's arguments filed 14 September 2007 regarding the rejection under 35 USC§101 have been fully considered but they are not persuasive. The rejections of claims 86, 90, 93-94, 97 and newly added claim 98 reading on the previously rejected claim 86 has been maintained.

3. The objection of claim 90 as a product-by-process claim has been maintained.

Election/Restrictions

4. Newly amended and submitted claims 89, 91-92, 99-110 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claim 89 as newly amended reads on an oil produced by a transgenic seed wherein the oil is still contained in said seed. There is no language in any of these claim indicating the oil has been expressed from the seed hence these claims basically as written are claim a seed which has this oil in it. Applicants have changed the scope of the invention and have presented a completely different invention for examination.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 89, 91-92, 99-110 withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Objections

5. Claim 90 is objected to as being drawn to compounds in the context of a product-by-process claim format. The objection is based on the fact that the compounds produced by the process are definite as to their meaning. As such, claims to the compounds can stand-alone. Product-by-process claim language is reserved for situations where the compound cannot be claimed in a definite manner. The instant application does not fall into this category, as the compounds are definite. Further, there is no showing that the process of making imparts new and unobvious properties to the compounds themselves.

Therefore, product-by-process claim 90 will be treated as compound claims for the purpose of this examination.

Applicants arguments have been taken into considered but the claim 90 as presented is deemed to be product-by-process claims and will be treated as such.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 86, 90, 93-94, 97 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Applicants arguments have been taken into consideration be the claims list supra are still considered to be non-statutory. While brassicastanol by not be a naturally occurring phytostanol, stigmastanol which the claims read is a commonly occurring plant stanol. Its presence alone substantiates the non-statutory rejection. As previously stated, the claimed inventions encompass untransformed seeds and its oil, which are a product of nature and not one of the five classes of patentable subject matter.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 86, 90, 93-94, 97 rejected under 35 U.S.C. 102(b) as being anticipated by Fernholz et al.

Fernholz et al. teaches an oil containing brassicasterol as one of its components. This oil reads on the instant oil, which only requires that one of the group consisting of brassicastanol, or its ester, stigmastanol, or it ester.

Applicants arguments have been taken into consideration be the claims list supra are still considered to be anticipated by Fernholz et al.

The requirement of the oil as presented is that it contains a compound selected from the group consisting of brassicastanol, or its ester, stigmastanol, or it ester.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., double bond at position C5 or C22 for either brassicastanol or stigmastanol) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

These compounds are conventionally known in the art as is their chemical structure. There was no indication that the instant compounds were structurally different still applicants referred to them by their conventionally known names. Therefore one would anticipate that if the compound is found in the prior art it is the same compound applicants are claiming. Fernholz et al. recites an oil containing brassicasterol therefore meeting the requirements of claim 86.

Conclusion

5. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deborah D. Carr whose telephone number is 571-272-0637. The examiner can normally be reached on Monday-Friday 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler can be reached on 571-272-0871. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Deborah D Carr/
Primary Examiner
Art Unit 1621

Ddc